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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,307	08/16/2000	Edouard A. Brodeur JR.	11-893	5059

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 01/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/639,307	Applicant(s) BRODEUR ET AL.	
	Examiner Cheryl Juska	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Amendment C, submitted as Paper No. 8 on October 29, 2002, has been entered. Claims 13, 14, 16-18, and 20 have been amended as requested. The pending claims are 13-20.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 17 has been amended to include the limitation that the carpet roll is “substantially void of curling.” It is unclear to the Examiner how a *roll* is void of curl. Does Applicant intend to describe the carpet while in roll form or in an installed form?

Claim Rejections - 35 USC § 102/103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 17, 18, and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5,567,497 issued to Zegler et al.

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Applicant has amended the claims to state that the open mesh fiber reinforced foam layer is “preformed” and the carpet roll is “substantially void of curling.” Thus, the prior 102 rejection has been changed to a 102/103 rejection.

Specifically, the “preformed” limitation is a method limitation in an article claim. As such, said limitation is not given patentable weight at this time since it has not been shown that said “preformed” limitation materially effects the final product. It is the Examiner’s position that the carpet roll of Zegler is identical to or only slightly different than the presently claimed carpet roll prepared by the “preformed” method presently claimed, because the final products are the same (i.e., a carpet roll comprising a tufted primary backing, an adhesive precoat, and a foam layer having a scrim reinforcements and foam nodules). If the product in the product-by-process claim is the same as or an obvious variant from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964. The burden has been shifted to the Applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289.

Although Zegler does not explicitly teach the limitation of curling, it is reasonable to presume that said limitation is inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. tufted primary backing, an adhesive precoat, and a foam layer having a scrim reinforcements and foam nodules) used to produce the carpet roll. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 495. In the alternative, the claimed carpet roll being void of curling would obviously have been provided by the carpet roll disclosed by Zegler. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the

providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

Claim Rejections - 35 USC § 103

6. Claims 13, 14, and 16 stand rejected under 35 U.S.C. 103(a) as being obvious over the cited Zegler patent in view of US 5,545,276 issued to Higgins.

Applicant has claim 13 in a manner analogous to that of claim 17. Thus, the present rejection is based upon argument presented in section 6 of the last Office Action, in conjunction with the arguments presented above with respect to Amendment C.

7. Claim 15 stands rejected under 35 U.S.C. 103(a) as being obvious over the cited Zegler and Higgins patents, as applied to claim 14 above, and in further view of US 4,018,957 issued to Werner et al. and/or US 3,945,955 issued to Ihde, Jr. for the reasons of record.

8. Claim 19 stands rejected under 35 U.S.C. 103(a) as being obvious over the cited Zegler patent, as applied to claim 18 above, and in further view of US 4,018,957 issued to Werner et al. and/or US 3,945,955 issued to Ihde, Jr. for the reasons of record.

Response to Arguments

9. Applicant's arguments filed with Amendment C have been fully considered but they are not persuasive.

10. Specifically, Applicant traverses the 102 rejection of claims 17, 18, and 20 by arguing that the in-situ foaming of Zegler creates a carpet tile having curl (Amendment C, page 5), which is contrary to the presently claimed invention of a preformed foam layer and a carpet roll being

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void of curl. Applicant notes the Brodeur Declaration, which was originally presented in the parent application (09/063,377), as support for said argument.

11. In response, it is reiterated that Applicant has not shown that the use of said “preformed” foam layer produces a materially different final product than that of Zegler’s in-situ foamed carpet. The Brodeur Declaration is merely an opinion and does not present any factual or objective evidence to support Brodeur’s conclusion that the Zegler product will have doming or curling (Declaration, section 4). Additionally, there is nothing on record establishing unexpected results (i.e., lack of curling) are obtained from employing the “preformed” foam layer. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) (“It is well settled that unexpected results must be established by factual evidence.” “[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of tests comparing appellant’s heat shrinkable articles with those of the closest prior art, we conclude that appellant’s assertions of unexpected results constitute mere argument.”). See also *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991). Therefore, the Brodeur Declaration is insufficient to overcome the prior art rejections based upon the cited Zegler patent.

12. With respect to the 103 rejection based upon Zegler in view of Higgins, Applicant relies upon the traversal of the Zegler reference, stating that Higgins does not cure the deficiencies of the Zegler reference (Amendment C, page 6, 2nd paragraph). As discussed above, it is the Examiner’s position that the Zegler reference is not deficient. Applicant also states, “the mere existence, per se, of a scrim says nothing about the obviousness of the claimed invention because virtually all inventions are combinations of known elements.” In response, it is noted proper

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motivation exists to combine the Higgins scrim with the Zegler carpet tile. Higgins teaches a scrim within the adhesive backcoat (i.e., precoat) is employed to reinforce the carpet tile, thereby improving the dimensional stability of said carpet tile. Thus, Applicant's arguments are found unpersuasive.

13. With respect to the rejections of claims 15 and 19, Applicant argues that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning. In response, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It is the Examiner's position that the rejection is based upon knowledge which is common and known to the art (i.e., known use of silicon surfactants in PVC compositions and fumed silica as filler). Thus, Applicant's arguments are found unpersuasive.

14. With respect to the Wilson Declaration, which attests to the commercial success of the present invention, said Declaration is deemed insufficient to overcome the prior art rejections. Specifically, said Declaration attributes the commercial success of the ERGOAIRE carpet products to comfort, reduced fatigue, and other ergonomic advantages (Declaration, sections 4 and 6). Thus, the evidence of commercial success is not commensurate in scope with the claims. In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), *aff'd*, 959 F.2d 226, 228, 22 USPQ2d

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1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.) In other words, the commercial success of ERGOAIRE must be due to the lack of curling or doming, as is presently claimed. With regard to said curling or doming, the Declaration states that this feature is what enables a life time guarantee to be given, but not that it is what sells the carpet. Therefore, said Wilson Declaration is insufficient to overcome the prior art rejections.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the


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Examiner should be directed to Cheryl Juska whose telephone number is 703-305-4472. The Examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

cj
January 9, 2003



CHERYL A. JUSKA
PRIMARY EXAMINER